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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,748	09/08/2003	Joerg Beringer	09282.0009-00	1142
22852 7590 02/13/2009 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER LOFTIS, JOHNNA RONEE	
			ART UNIT 3624	PAPER NUMBER
			MAIL DATE 02/13/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/657,748	BERINGER ET AL.	
	Examiner	Art Unit	
	JOHNNA R. LOFTIS	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-65 is/are pending in the application.
- 4a) Of the above claim(s) 53-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-52 and 57-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/19/08, 1/27/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a final office action upon examination of application number 10/657,748. Claims 1, 18-21, 31, 41, 42, 52 and 57 amended. Claim 22 canceled. Claims 1-21 and 23-65 are pending with claims 53-56 previously withdrawn. Pending claims have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments filed with respect to previous rejections under 35 USC 101 have been fully considered but they are not persuasive. While Applicant has amended claims to recite that information is displayed on a dashboard, Examiner submits this is considered insignificant extra-solution activity and refers Applicant to the memorandum from the Deputy Commissioner for Patent Examination Policy dated January 7, 2009. The memorandum explains insignificant extra-solution activity will not transform an unpatentable principle in a patentable process. This means reciting a specific machine or particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. Further, while a *dashboard* is recited, there is still no tie to a particular machine or apparatus. Thus, the claim still is non-statutory based on the guidelines in the above stated memorandum. Previous rejections under 35 USC 101 are upheld and are reproduced below.

3. Applicant's clarification with respect to claims previously rejected under 35 USC 112 have been fully considered and are persuasive. The rejections of claims 18, 19, 21, 41 and 52 under 35 USC 112 have been withdrawn.

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4. Applicant's arguments with respect to claims previously rejected in view of Sarin, US 6,003,011 have been considered but are moot in view of the new ground(s) of rejection. An article directed to the ProjectDash service wherein task/project information is displayed using a graphical dashboard.

5. Applicant has attempted to challenge the Examiner's taking of Official Notice in the Office Action mailed 8/19/08. There are minimum requirements for a challenge to Official Notice:

(a) In general, a challenge, to be proper, must contain adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice

(b) Applicants must seasonably traverse (challenge) the taking of Official Notice as soon as practicable, meaning the next response following an Office Action. If an applicant fails to seasonably traverse the Official Notice during examination, his right to challenge the Official Notice is waived.

Bald statements such as, "the Examiner has not provided proof that this element is well known" or "applicant disagrees with the Examiner's taking of Official Notice and hereby requests evidence in support thereof", are not adequate and do not shift the burden to the Examiner to provide evidence in support of the Official Notice.

Applicant has not provided adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-5, 7, 8, 10-30 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-5, 7, 8, 10-30 are non-statutory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-21, 23-52 and 57-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Sarin et al, US 6,003,011, in view of ProjectDash, as evidenced by the article entitled, "ProjectDash Drives Consistency in Communicating Project Status Online using Innovative Graphical Project Dashboard".

As per claim 1, Sarin et al teaches specifying one or more actions corresponding to a specified procedure and, for each specified action, one or more resources associated with the action; indicating an action order, including indicating whether the two or more of the specified actions are to be performed in an order-dependent manner or in an order-independent manner; presenting the specified actions to a user in a presentation format; and enabling the user to perform the specified action by providing access to the resources associated with the specified procedure (column 3, lines 30-67 – a tasks set forth in a workflow process with each resource associated; icons represent tasks to be performed; resources are made available to user to perform tasks; column 4, lines 11-20 – interrelationship of tasks set forth indicating order-dependency). Sarin et al does not explicitly teach displaying a dashboard to the user to display or link to status information of procedures started or monitored by the user, wherein at least one of the procedures is marked to alert the user that the procedure requires attention. ProjectDash teaches a method for capturing project status and communication performance. A graphical

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dashboard is used to keep users current on critical aspects of a project. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Sarin et al the ability to display a dashboard with project status as taught by the ProjectDash article since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 2, Sarin et al teaches the specified actions are identified by a process pattern associated with the specified procedure (column 4, lines 11-20 - interrelationships established).

As per claim 3, Sarin et al teaches identifying one or more common action patterns; abstracting each reusable common action pattern; and providing a template including the abstracted patterns for the specified procedure based on business context (column 7, lines 1-22)

As per claim 4, Sarin et al teaches comprising enabling the user to modify the template with ad-hoc collaboration actions based on work practice for a particular business scenario (column 7, lines 46-65; column 10, lines 36-63).

As per claim 5, Sarin et al teaches automatically adapting the template based on collaborative filtering or history tracking (column 7, lines 46-65 – historical contributions used to adapt template).

As per claim 6, Sarin et al teaches the action makes a process pattern plug&execute by launching web-based services with semantics and functionality (column 8, lines 51-58).

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As per claim 7, Sarin et al teaches introducing rules and pre-configuring ad-hoc coordination patterns to handle exceptions and dependencies within actions (column 7, line 67—column 8, line 2 – interrelationships retained).

As per claim 8, Sarin et al does not explicitly teach providing hybrid service that encapsulates transactional enterprise services and the related exception handling. Examiner takes official notice that it is old and well known to provide exception handling within workflow systems. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate standard exception handling into the invention of Sarin et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

As per claim 9, Sarin et al teaches an action launches an enterprise service directly or dissolves the service through a request to an UDDI server (column 1, lines 41-67 – column 3, lines 30-67).

As per claim 10, Sarin et al teaches comprising instantiating a sub-procedure from the specified procedure (column 3, lines 48-56 – scanning is optional sub-procedure).

As per claim 11, Sarin et al teaches the specified procedure controls the sub procedure including stopping, freezing and waiting for the sub-procedure (column 7, lines 23-46).

As per claim 12, Sarin et al teaches the actions are grouped into phases (column 3, lines 35-39 – column 6, lines 29-45 – life cycle of process instance).

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As per claim 13, Sarin et al teaches a navigational model includes a phase indicator to navigate by phases of the procedure and display of actions and deliverables associated with the phase (column 3, lines 30-67 – display shows progress along with deliverables).

As per claim 14, Sarin et al teaches completion of a phase is a gate in a process that requires satisfaction of conditions from a higher level semantic before completion of the phase (column 3, lines 46-67, column 4, lines 1-10 – one finished task “calls forth” the next task).

As per claim 15, Sarin et al teaches enabling a user to include ad-hoc collaboration actions (column 9, lines 50-67).

As per claim 16, Sarin et al teaches the ad-hoc collaboration actions comprise delegating a procedure or portion thereof, delegating an action that has been started, requesting approval, requesting a review or getting an opinion of another user (column 9, lines 50-67).

As per claim 17, Sarin et al teaches associating deliverables, contributors and resources with an action (column 6, lines 5-11).

As per claim 18, Sarin et al teaches providing displays for tracking the status of deliverables, contributors, resources, metrics, accomplish view, forecast view, procedure tree view or delta view (column 3, lines 46-67; column 6, lines 29-45 – lifecycle of tracks status of what has been accomplished).

As per claim 19, teaches the metrics comprise frequency of use, average temporal duration, efficiency, number of breakdowns, iterations and quality of outcome

As per claim 20, Sarin et al teaches the accomplish view comprises new deliverables, completed steps, steps started but not yet completed or the difference between two action

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completion dates (column 3, lines 46-67; column 6, lines 29-45 – lifecycle of tracks status of what has been accomplished).

As per claim 21, Sarin et al teaches the delta view provides a display comprising the differences between an accomplish from a first time and an accomplish view from a second time

As per claim 23, Sarin et al teaches providing aggregate status information to another application or user interface pattern (column 5, lines 4-24 – status shown).

As per claim 24, Sarin et al teaches the list of one or more actions comprises specifying whether an action is optional, mandatory or protected (column 9, line 64 – column 10, line 4 – permissions indicate protection).

As per claim 25, Sarin et al teaches enabling the user to specify that the specified procedure requires collaboration among two or more contributors (column 3, lines 46-67 - administrator fills in amounts, then account must review as well as manager must sign).

As per claim 26, Sarin et al teaches enabling the user to determine a guided procedure trigger (column 4, lines 10-20).

As per claim 27, Sarin et al teaches enabling the user to back track to previous actions (column 10, lines 25-35 – user may backtrack and modify processes).

As per claim 28, Sarin et al does not explicitly teaches automatically invalidating the specified procedure in selected cases where the guided procedure trigger ceases to exist.

Examiner takes official notice that it would have been obvious to one of ordinary skill in the art that the failure to determine a procedure trigger would render a procedure invalid since there would be nothing set forth to indicate procedure order. The invalidation of a procedure without a

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procedure trigger would allow for a more efficient workflow system since those procedures without specified order dependencies would not be executed.

As per claim 29, Sarin et al does not explicitly teach modification of the template is aided by a wizard. While Sarin et al teaches the modification of templates (column 9, line 51 - column 10, line 63). Examiner takes official notice that it is old and well known to employ template wizards that enable a user to more accurately complete a template. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate standard wizard technology into the invention of Sarin et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

As per claim 30, Sarin et al teaches enabling the user to link the specified procedure to a pre-existing procedure definition such that subsequent modifications made to the pre-existing procedure definition are automatically reflected in the specified procedure (column 10, lines 36-63).

Claims 31-41 are directed to the system that performs the method of claims 1-7, 10, 11 and 18 and are therefore rejected using the same rationale set forth above.

Claims 42-52 are directed to the article of manufacture with stored instructions operable to perform the method of claims 1-7, 10, 11 and 18 and are therefore rejected using the same rationale set forth above.

Claims 57-61 are directed to the system to perform the method of claims 1-7, 10, 11 and 18 and are therefore rejected using the same rationale set forth above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

“3Com Palm VII Wireless Access Now Available for the Project Gateway Enterprise Project Management System”

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brad Bayat can be reached on 571-272-6636. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/
2/3/09

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624